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R.L.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/920,070	08/26/97	SULLIVAN	M SLD-2-035-3-

EXAMINER

QM12/0620

DIANE F. COVELLO, ESQ.
DIVISION PATENT & TRADEMARK COUNSEL
SPALDING SPORTS WORLDWIDE, INC.
425 MEADOW STREET-P.O.BOX 901
CHICOPEE MA 01021-0901

GRAHAM, M	
ART UNIT	PAPER NUMBER

3711
DATE MAILED:

27
06/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/920,070

Applicant(s)

Sullivan

Examiner

Mark S. Graham

Group Art Unit

3711

☒ Responsive to communication(s) filed on Apr 7, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-3, and 8 are rejected under 35 U.S.C. § 103 as being unpatentable over Nesbitt in view of Nakamura for the reasons set forth in the previous action.

In response to applicants remark entitled A.1. the examiner responds as follows:

The applicant is claiming a low acid material. Applicant states that Nesbitt discloses a low acid material. Applicant's argument merely bolsters that of the examiner.

In response to applicants remark entitled A.2. the examiner responds as follows:

Nakamura discloses the claimed material having an acid content of less than 16%. It is irrelevant whether Nakamura distinguishes between "low" and "high" acid as defined by applicant. Applicant has claimed that the acid content be "no more than 16%". Nakamura's material meets this limitation. If applicant's material is "low acid" when it is 16% or less than Nakamura's material is "low acid" when it is 16% or less. Again it would appear that applicant's remarks merely bolster the examiner's argument.

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In response to applicants remark entitled A.3. the examiner responds as follows:

Even assuming arguendo that Nakamura does not disclose a "high acid" ionomer the point is irrelevant as the applicant is claiming a "low acid" ionomer.

In response to applicants remark entitled A.4. the examiner responds as follows:

Again applicant is claiming a low acid ionomer and not a high acid ionomer. However, "commercial availability" is not a condition of patentability.

In response to applicants remark entitled A.5. the examiner responds as follows:

Note Nesbitt at Col. 3, lines 16-25. Regarding claims 4-6 and 8 the rejections based on prior art have been withdrawn. Regarding claim 7, Nesbitt teaches that the inner layer modulus should be relatively high while that of the outer layer should be relatively low. The ranges claimed by the applicant are within those commonly known for golf ball cover materials and absent a showing of criticality are not considered unobvious.

In response to applicants remark entitled A.6. the examiner responds as follows:

No nexus has been shown between the alleged commercial success and the particularly claimed features of the ball of claims 1-8.

Claims 1-8 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-8 of copending Application No. 08/926,246. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application

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since the referenced copending application and the instant application are claiming common subject matter, as follows: a golf ball with a hard inner and soft outer layer.


Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending applications. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number (703) 308-1355.

MSG
June 16, 2000



Mark S. Graham
Primary Examiner